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**REMARKS**

This amendment is intended as a full and complete response to the final Action mailed August 14, 2003. In the Action, the Examiner notes that claims 1-15 are pending, of which claims 1-15 stand rejected. By this amendment, claims 1-15 continue unamended.

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provision of 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant responsive amendments.

**REJECTION OF CLAIMS UNDER 35 U.S.C. §103****Claims 1-2, 4, and 6-8**

Claims 1-2, 4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Patent Application No. WO 98/48566 to Mankovitz (hereinafter "Mankovitz") in view of U.S. Patent No. 5,729,280 to Inoue et al (hereinafter "Inoue"). The rejection is respectfully traversed.

Claim 1 recites:

In an interactive information distribution system including information provider equipment and information consumer equipment, a method for use in an information server comprising the steps of:

providing a primary video-on-demand (VOD) content stream to an information consumer; and in response to a stop or pause command received from said information consumer, performing the steps of:

halting the providing of said primary VOD content stream to said information consumer; and  
providing a secondary content to said information consumer. (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the

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claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Clr. 1984) (emphasis added).

In particular, the Mankovitz reference teaches:

"To enable a television viewer to access information about a television program that the viewer is watching, PRI is embedded in the VBI of the television carrying the television program. For example, the PRI may be textual information regarding actors and actresses in the show, advertisements of program-related merchandise, brief descriptions of the plot of future episodes of the television program, or any other text regarding the television program, or the PRI may be text representing web pages containing such information." (See Mankovitz, pg. 5, lines 15-21).

However, the Mankovitz reference fails to teach and suggest "providing a primary video-on-demand (VOD) content stream to an information consumer". Rather, the Mankovitz reference merely discloses broadcasting television programs and including content based on a personalized file of an end-user during vertical blanking. Therefore, the Mankovitz reference fails to teach or suggest the Applicants' invention as a whole.

Furthermore, the Inoue reference fails to bridge the substantial gap as between the Mankovitz reference and the Applicants' invention. In particular, the Inoue reference teaches providing near video-on-demand (NVOD) services, as opposed to providing video-on-demand services. Specifically, the Inoue reference teaches providing a near video-on-demand signal receiver capable of pausing a display of a video program transmitted by a broadcaster and resuming display of the program from that point without additional delay. Near video-on-demand, as defined in the new reference is also called a "time interval transmitting system" in which a single video program is broadcast on multiple channels with a short interval between the starting time of each program broadcast. For example, a two-hour movie may be broadcast on seven consecutive channels with the starting broadcast time of each channel offset by 15 minutes from that of a neighboring channel, such that the beginning of the movie is effectively available on one of the channels once every 15 minutes. (See, Inoue, col. 1, lines 46-67, and col. 2, lines 33-57). Accordingly, near video-on-demand is not the same as video-on-demand services, since video-on-demand services provide content to

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a subscriber at any time of the day, as opposed to near video-on-demand services that provide content at particular time slots on various channels.

The references must be taken in their entireties, including those portions which argue against obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q. 416, 420 Fed. Cir. 1986). It is impermissible within the framework of the 35 U.S.C. § 103 to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. Id. at 419. In this instance the Examiner has improperly picked and chose various teachings of the cited references to improperly support a conclusion of obviousness to the exclusion of other parts necessary to provide a full appreciation of what the references fairly suggest to one skilled in the art.

In particular, neither the Mankovitz or the Inoue reference teach or suggest video-on-demand services. Rather, the Mankovitz reference merely discloses broadcasting television programs, while Inoue reference merely discloses near video-on-demand services. Neither of the references either singularly or in combination teach or suggest that a response to a stop or pause command received from an information consumer equipment halts the providing of the primary VOD content stream to the information consumer and provides a secondary content to the information consumer. Thus, the combining of these two references is improper because neither of the references provide any teaching, suggestion, or motivation that the halting of the providing of the primary content stream and providing a secondary content to the information consumer in response to a stop or pause command is applicable to a system that provides video-on-demand services, as opposed to television broadcasting programs or near video-on-demand services.

Moreover, even if the two references could operably be combined, the combination would merely disclose either broadcasting a television program to a viewer and embedding program-related information (PRI) embedded in the vertical blanking interval (VBI) of the television carrying the television program, where the PRI may include advertisement related to the programming or near video-on-demand content provided over a plurality of channels during particular time slots, and in an instance where a subscriber pauses/stops the NVOD, a second program may be provided to the

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subscriber. This is completely different from the Applicants' invention, since the Applicants' invention provides a primary video-on-demand content stream to an information consumer, and in a response to a stop or pause command received from the information consumer, the primary VOD content stream is halted and a secondary content is then provided to the information consumer. Nowhere in the combined references is there any teaching or suggestion of providing a primary video-on-demand content stream, and in response to a stop or pause command received by the information consumer, halting the primary video-on-demand content stream, and then providing secondary content to the information consumer. Therefore, the combined references fail to teach the Applicants' invention as a whole.

#### Claim 4

With respect to dependent claim 4, neither of the references, either singularly or in combination, teach or suggest "wherein said secondary content provided to said information consumer is determined with respect to a segment of said primary VOD contents stream being presented to said information consumer contemporaneous to said stop or pause command." As discussed above, the Mankovitz reference merely discloses that advertisements of program related merchandise, brief descriptions of the plot of future episodes of the television program, or any other text regarding the television program may be provided in the VBI of the television carrying the television program (see, Mankovitz, page 5, lines 15-21). Although the Mankovitz reference discloses that advertisements associated with the television program may be sent with the television program, nowhere is there any teaching or suggestion that such advertisements are associated with a particular segment of the primary VOD content stream being presented to the information consumer contemporaneous to the stop or pause command. That is, "the set-top box 142, upon receiving the stop or pause command, causes the present frame to be "frozen" and decimated such that the frozen frame occupies the linear portion of display area of the presentation device. The set-top box 142 then extracts advertisement information associated with the presently displayed scene. The advertisement information presented on the display screen and a user operating the user-input device 146 may select particular advertisements for subsequent presentation" (see, Applicants' specification, page 9, lines 9-16).

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Furthermore, the Inoue reference fails to breach a substantial gap as between the Mankovitz reference and the Applicants' invention. In particular, the Inoue reference merely discloses that when a viewer selects a stop or pause button while receiving a near video-on-demand program, the video program may continue to be displayed, another program may be received and displayed, or a pause graphic screen may be generated by the microcomputer and displayed (see, Inoue, col. 6, lines 29-32). Thus, the combination of Mankovitz and Inoue fail to teach or suggest the Applicants' invention as a whole, since the combined references fail to teach or suggest that "secondary content provided to said information consumer is determined with respect to a segment of said primary VOD content stream being presented to the information consumer contemporaneous to said stop or pause command."

As such, the Applicants submit that claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 2, 4 and 6-8 depend from independent claim 1 and recite similar features thereof. As such and at least for the same reasons discussed above, the Applicants submit that these claims are also not obvious and fully satisfy the requirement under 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

#### Claims 3, 5 and 9

The Examiner rejected claims 3, 5 and 9 under 35 U.S.C. §103(a) as being unpatentable over Mankovitz in view of Inoue and further in view of Dedrick U.S. Patent No. 5,724,520, issued March 3, 1998. The rejection is respectfully traversed.

Claim 3 depends from independent claim 1 and recites additional features thereof. In particular, claim 3 when combined with independent claim 1 recites:

In an interactive information distribution system including information provider equipment and information consumer equipment, a method for use in an information server comprising the steps of:

providing a primary video-on-demand (VOD) content stream to an information consumer; and in response to a stop or pause command received from said information consumer, performing the steps of:

halting the providing of said primary VOD content stream to said information consumer; and

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providing a secondary content to said information consumer;  
wherein said secondary content provided to said information consumer is determined with respect to a demographic profile associated with said information consumer.

The Mankovitz reference teaches:

"To enable a television viewer to access information about a television program that the viewer is watching, PR1 is embedded in the VBI of the television carrying the television program. For example, the PR1 may be textual information regarding actors and actresses in the show, advertisements of program-related merchandise, brief descriptions of the plot of future episodes of the television program, or any other text regarding the television program, or the PR1 may be text representing web pages containing such information." (See Mankovitz, pg. 5, lines 15-21).

However, the Mankovitz reference fails to teach and suggest "providing a primary video-on-demand (VOD) content stream to an information consumer." Rather, the Mankovitz reference merely discloses broadcasting television programs and including content based on a personalized file of an end-user during vertical blanking. Therefore, the Mankovitz reference fails to teach or suggest the Applicants' invention as a whole.

Furthermore, the Inoue reference fails to bridge the substantial gap as between the Mankovitz reference and the Applicants' invention. In particular, the Inoue reference teaches a near video-on-demand signal receiver capable of pausing a display of a video program transmitted by a broadcaster and resuming display of the program from that point without additional delay. During the pause, the video program may continue to be displayed, another program may be received and displayed, or a pause graphic screen may be generated by the microprocessor and displayed (see Inoue, Col. 2, lines 48-52 and col. 6, lines 29-32). However, nowhere is there any teaching or suggestion in the Inoue reference of "providing a primary video-on-demand (VOD) content stream to an information consumer."

Furthermore, the Dedrick reference fails to bridge the substantial gap as between the Mankovitz and Inoue references and the Applicants' invention. In particular, the Dedrick reference teaches collecting personal profiled data from input by an end-user, monitoring new client activity, and using the collected personalized data to customize

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electronic content to the end-user. (See Dedrick, Col. 8, lines 17-39). However, nowhere is there any teaching or suggestion in the Dedrick reference of "providing a primary video-on-demand (VOD) content stream to an information consumer."

Moreover, even if the two references could operably be combined, the combination would merely disclose sending either a television program or near video-on-demand programs and in response to a pause command, sending advertisement information associated with the broadcast program, and using collected personalized data to customize electronic content to the end user. Nowhere in the combined references is there any teaching or suggestion of providing a primary video-on-demand content stream, and a response to a stop or pause command received by the information consumer, halting the primary video-on-demand content stream, and then providing secondary content to the information consumer. Therefore, the combined references fail to teach the Applicants' invention as a whole.

As such, the Applicants submit that claim 3 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 5 and 9 also depend from independent claim 1 and recite similar features thereof. As such and at least for the same reasons discussed above, the Applicants submit that these claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

#### Claims 10-15

The Examiner has rejected claims 10-15 under 35 U.S.C. 103 as being unpatentable over Dedrick in view of Mankovitz and further in view of Inoue. The Applicants' respectfully traverse the rejection.

Claim 10 recites similar features as recited in independent claim 1. In particular, claim 10, as amended, recites:

In an interactive information distribution system including provider equipment and subscriber equipment, provider apparatus comprising:  
a head end controller for interacting with subscriber equipment;  
a video server, responsive to said head end controller for providing a primary video-on-demand (VOD) content streams;

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a transport processor, for communicating VOD content to said subscriber equipment via a distribution network; and  
an advertisement manager, responsive to said head end controller for providing secondary content;  
said head end controller, in response to a stop or pause command received from said subscriber equipment, causing said advertisement manager to provide said secondary content to said transport processor for communication to said subscriber equipment. (emphasis added).

As discussed above, with respect to claims 1-9, the three references fail to teach and suggest "providing a primary video-on-demand (VOD) content stream to an information consumer". Rather, the Mankovitz and Dedrick references merely disclose broadcasting television programs and including content based on a personalized file of an end-user during vertical blanking. Further, as the Examiner concedes, the combination of Mankovitz and Dedrick fails to teach or suggest a system wherein the primary content stream is a video-on-demand (VOD) stream. Therefore, the Mankovitz and Dedrick references fail to teach or suggest the Applicants' invention as a whole.

Furthermore, the Inoue reference fails to bridge the substantial gap as between the Mankovitz and Dedrick references and the Applicants' invention. The Examiner contends that the Inoue reference discloses a video-signal receiver adapted to allow a user to request the reception and display of video-on-demand programming. However, the teaching of the Inoue reference are not for video-on-demand, but are directed towards near video-on-demand services. Specifically, the Inoue reference merely teaches a near video-on-demand signal receiver capable of pausing a display of a video program transmitted by a broadcaster and resuming display of the program from that point without additional delay (see, Inoue, col. 2, lines 48-52). However, nowhere is there any teaching or suggestion in the Inoue reference of providing a primary video-on-demand content stream, and a response to a stop or pause command received by the information consumer halting the primary video-on-demand content stream and then providing secondary content to the information consumer.

That is, the Applicants' invention provides primary video-on-demand content stream to an information consumer and a response to a stop or pause command received from the information consumer, the primary VOD content stream is halted and a secondary content is then provided to the information consumer, while the



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combination of references cited by the Examiner teaches away from video-on-demand services. Therefore, the three references fail to teach the Applicants' invention as a whole.

As such, the Applicants submit that independent claim 10 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 11-15 depend from independent claim 10 and recite additional features thereof. As such and at least for the same reasons discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of the 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

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### CONCLUSION

Thus, the Applicants submit that claims 1-15 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Steven M. Hertzberg or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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